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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,405	09/04/2001	Yrjo Holopainen	1123.40625X00	1195

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EXAMINER

JACKSON, JENISE E

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 03/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/944,405

Applicant(s)

HOLOPAINEN, YRJO

Examiner

Jenise E Jackson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 7, 8, 10, 15 and 20 is/are rejected.
- 7) ☒ Claim(s) 3-6, 9, 11-14 and 16-19 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

Notice of References Cited	Application/Control No. 09/944,405	Applicant(s)/Patent Under Reexamination HOLOPAINEN, YRJO	
	Examiner Jenise E Jackson	Art Unit 2131	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-5,754,761	05-1998	Willsey, John A.	713/200
	B	US-6,189,146	02-2001	Misra et al.	717/177
	C	US-5,734,819	03-1998	Lewis, David Otto	713/200
	D	US-5,592,651	01-1997	Rackman, Michael I.	711/163
	E	US-4,757,534	07-1988	Matyas et al.	705/56
	F	US-6,810,387	10-2004	Yim, Myung-Sik	705/57
	G	US-5,109,413	04-1992	Comerford et al.	705/54
	H	US-6,289,455	09-2001	Kocher et al.	713/194
	I	US-6,725,205	04-2004	Weiler et al.	705/57
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Willsey(5,754,761).

3. As per claim 1, Willsey(5,754,761) the method for preventing unauthorized use of software(see col. 3, lines 42-49) accessing at least one specific hardware module including a unique hardware identification sequence(see col. 3, lines 44-55, 60-61, col. 4, lines 1-5)(see col. 4, lines 26-35) wherein said software includes a license key(see col. 3, lines 8-12) for being executed(see col. 3, lines 8-12), including reading out said hardware identification sequence of said at least one specific hardware module, retrieving a predetermined hardware identification sequence contained in said license key, comparing said read-out hardware identification sequence with said hardware identification sequence contained in the license key; and permitting execution of said software if both sequences match(see col.4, lines 23-38).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 2, 7, 10, are rejected under 35 U.S.C. 103(a) as being unpatentable over Willsey(5,754,761) in view of Misra(6,189,146).

6. As per claim 2, Willsey(5,754,761) discloses a hardware identification sequence(see col. 3, lines 44-55, 60-61, col. 4, lines 1-5), and a license key that contains a hardware identification sequence(see col. 8, lines 8-12). However, Willsey does not disclose that the hardware identification sequence is encrypted. Misra et al. discloses that the hardware identification sequence is encrypted(see col. 11, lines 53-57). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the hardware identification sequence that is encrypted in Misra et al. with Willsey, the motivation is that when a hardware identification sequence is encrypted it prevents a client from looking within a license to find its associated hardware id(i.e. client id)(see col. 11, lines 53-57 of Misra et al.).

7. As per claim 7, and 10, Willsey does not disclose a public key that is accessible freely. Misra discloses a public key that is accessible freely(see col. 11, lines 65-67, col. 12, lines 1-7). It would have been obvious to one of ordinary skill in the art at the time of the invention to include a public key that is accessible freely of Misra with Willsey, the motivation is that the license server encrypts the license using the clients public key; therefore, because licenses are tied to specific clients thorough an client id, the software licenses cannot be activated on other clients(see col. 11, lines 66-67, col. 12, lines 1-7 of Misra).

8. Claims 8, 15 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Willsey in view of Misra as applied to claim 1 above, and further in view of Lewis(5,734,819).

9. As per Claims 8, 15, and 20, Willsey-Misra combination discloses a hardware module(see col. 3, lines 44-55, 60-61, col. 4, lines 1-5); however, do not disclose that the

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hardware module is a network interface module including a unique network address(MAC).

Lewis discloses that the hardware module is a network interface module including a unique network address(MAC). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the hardware module is a network interface module including a unique network address(MAC) of Lewis with Willsey-Misra, the motivation is that by using a message authentication code, is a more efficient method that can detect any duplication or modification, Lewis discloses that the unique chip identifier includes data that the manufacturer wants to prevent from being modified(see col. 2, lines 1-50 of Lewis).

10. Claims 3-6, 9, 11-14, 16-19 are objected to as being rejected on base claims. The reasons why these claims are allowable are for the features of “the secret key coded in the software to decrypt the hardware id sequence, and the secret key which is only known to the license key distribution authorities, and a second secret key which is known to a third authority. In the prior art of copy protection, prior art fails to disclose the limitations above. In contrast, prior art discloses that software is used on specific/unique client machines. The software contains a license key which is known in the art. The license key contains the serial number of the software, and is usually compared to the license key stored in the database of the manufacturer. Also, in prior art the license key can contain the serial number of a hardware device such that a specific hardware device is used with a specific software and if they are compared, and the same authorization is granted. Prior art discloses encrypting a hardware id, with a public key, but not decrypting with a secret key which is only known to the distribution authorities.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenise E Jackson whose telephone number is (571) 272-3791. The examiner can normally be reached on M-Th (6:00 a.m. - 3:30 p.m.) alternate Friday's.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



March 10, 2005



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